2 5 SEP 2001 HAND CARRY TO THE PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

CUNNINGHAM, et al.

Serial Number: 09/701,395

Filed: June 2, 1999

For:

GENES OF CAROTENOID BIOSYNTHESIS AND METABOLISM AND

METHODS OF USE THEREOF

REQUEST FOR CORRECTION OF PATENT OFFICE RECORDS AND RECONSIDERATION OF ERRONEOUS HOLDING OF MISSING PARTS

Commissioner for Patents Washington, D.C. 20231

September 25, 2001

Sir:

A Third Notification of Missing Requirements (copy attached) was mailed from the U.S. Patent and Trademark Office to the firm of Arent Fox Kintner Plotkin and Kahn, PLLC. on July 11, 2001. A Fourth Notification of Missing Requirements (copy also attached) was mailed on July 25, 2001.

However, contrary to each of the Notifications, a first Response to Notification of Missing Requirements was filed on June 18, 2001 containing the declaration, an assignment document for recording along with the 1 595 form, and a Preliminary Amendment. A second Response to Notification of Missing Requirements was filed on July 2, 2001 containing a Statement under 37 CFR §1.821(c), a Sequence Listing in computer readable form and paper copy. Attached please find a copy of the filing from June 18, 2001 and July 2, 2001 along with the applicants' attorneys' return-receipt

postcard.

In view of the foregoing, the applicants respectfully request that the U.S.

Patent and Trademark Office's records be corrected to show that a proper response was

timely filed.

Any fees associated with this communication should be waived since the

evidence submitted herewith shows that the applicants are in no way at fault, and a timely

response was filed.

The Commissioner is hereby authorized to charge any fees associated with

this communication to Deposit Account No. 01-2300. A duplicate copy of this request is

attached.

Should the appropriate official of the U.S. Patent and Trademark Office have

any questions, that official is requested to telephone the applicants' undersigned attorney.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN

Richard & Berman

Attorney for Applicant(s)

Reg. No. 39,107

1050 Connecticut Avenue, N.W., Suite 400

Washington, D.C. 20036-5339

Tel: (202) 857-6000

RJB:ccd

Enclosures: Copies of the Notifications of Missing Requirements / postcard receipts / Responses to the Notification of Missing Requirements (as filed on June 18, 2001 and

June 2, 2001

2

Commissioner for Patents, Box PCT United States Patent and Trademark Office Washington, D.C. 20231

U.S. APPLICATION NO.			nt and Trademark Office Washington, D.C. 20231	
09/701395	FIRST NAMED APPLICANT	ATTY. DO	www.uspto.gov	
33 3.1333	CUNNINGHAM	F P10817	72-0002	
ARENT FOX KINTNER PLOTK	CINI O IGALINA	INTERNATIONAL APPLICATIO	IN NO.	
1050 CONNECTICUT AVENUE	= 8134	PCT/US99/1212	:1	
WASHINGTON, DC 20036 533	9	I.A. FILING DATE PRI	IORITY DATE	
(1) INDH1 , FKH111	1 R. a 1108	02 1111 00	2 JUN 98	
) 1001 K 00 WX	- DIGH HIDH)	· II	5	
NOTHELEATION OF MIS	SINCEPEOLINE	DATE MAILED:	UL 2001	
STATES	SING REQUIREMENTS UNDER DESIGNATED ELECTED OFF	R 35 U.S.C. 371 IN THE U	UNITED	
1. The following items have been su	thmitted by the and	-OE (DO/EO/05)		
☐ a Designated O	, [4 =: 5:00:00 Oil	VE (3/ CPR 1 405)		
Copy of the international				
Oath or Declaration of in	iventors(s)	ntity Status. ernational application into English. 19 amendments into English.	Receive	
Copy of Article 19 amend	dments. Other:	19 amendments into English.	TECRETA GOI	
Priority Document. The International Prelimin		r	0.015755	
Translation of Annexes to	nary Examination Report in English and it	s Annexes, if any.	JULY 1 3 2001	
_	and international Fremminary Examination	1 Report into English	TOR HOR	
the indicated items in paragraph 3 by	ocessing under 35 U.S.C. 371(f) but has r	ot filed the following indicated	XG, Land	
prior to 20 or 30 months from the prior U.S. Basic National Fee.	rity date to avoid abandonment.	n die international application must	be filed	
•	Copy of the internation	at application.		
acceptance under 35 U.S.C. 371:	ished within the period set forth below in	order to complete the requirements	for	
	ation into English A processing Co	•		
The current translation	iate 20 or 30 months from the priority date in is defective for the reasons indicated on	2,		
Translation.		the attached Notice of Defective		
appropriate 20 or 30 p	ding the translation of the application and/o	or the Annexes later than the		
C. Oath or declaration of the	e inventors in compliance (37 CFR 1.4	92(f)).		
c. Oath or declaration of the inventors, in compliance with 37 CFR 1.492(f)). the application (preferably by the International application number and international filing date). A date.				
date.	are appropriate	20 or 30 months from the priority		
I he current oath or dec	claration does not comply with an one	197(a) and (b) for the		
indicated on the attache attache d. Surcharge for providing the	ed PCT/DO/EO/917. the oath or declaration later than the appropriate that the propriate	(b) for the reasons		
priority date (37 CFR 1	.492(e)).	oriate 20 or 30 months from the		
claim fee, are required. Applicant must a	1.492(e)). as a large entity small entity, in submit the additional claim fees or cancel t	cluding any required multiple deper	adon.	
claim fee, are required. Applicant must s due (37 CFR 1.492(g)). See attached PTG	domit the additional claim fees or cancel to 0-875.	he additional claims for which fees	are	
			·	
 Applicant has not submitted the requestion PCT/DO/EO/920. 	arred sequence fisting pursuant to 37 CFR	1.821-1.825. See attached		
ALL OF THE ITEMS SET FORTH IN	3(0) 2(4) 4 4379 5 17 27		•	
ALL OF THE ITEMS SET FORTH IN MONTHS FROM THE DATE OF THIS THE PRIORITY DATE FOR THE APP RESPOND WILL BESILT IN ARAPS	S NOTICE OR BY 22 OR 32 MONTHS	SUBMITTED WITHIN TWO (2)		
THE PRIORITY DATE FOR THE APP RESPOND WILL RESULT IN ABANDA		. FAILURE TO PROPERLY	ОМ	
The time period set above may be extended 1.136(a).	by filing a petition and fee for extension	of time under the provisions of 37 C	CFR	
6. If box 3a or 3c is checked a second				
6. If box 3a or 3c is checked, a translation Annexes will be cancelled. A processing fe 7. The Article 19 amendments are cancelled (37 CFR) to 19 amendments are cancelled (37 CFR) to 19 amendments are cancelled (37 CFR).	of the Annexes MUST be submitted no la	ter than the time period set above or	r the	
7. The Article 19 amendments are cancer or 30 (37 CFR 1.495(d)) months from the p		to or 30 months from the priority days the appropriate 20 (37 CFR 1.49)	ite. 4(d))	
Applicant is reminded that any account				
address given in the heading and include the	U.S. application no. shown above. (37 C	ark Office must be mailed to the FR 1.5)		
A copy of this no	otice MUST be returned with	this seems		
TOTAL COMP	Liver of Detective Translation	uis response.	,	
□.10-8/3	PCT/DO/EQ/920	≈4.1.14		
FORM PCT/DO/EO/905 (March 2001)		nt Hunt r		
	Telephone: 703-	305-3686		
	(////////			
	10.00 m			

Commissioner for Patents, Box PCT Inited States Patent and Trademark Office Washington, D.C., 20231

U.S. APPLICATION NO.				washington, D.C.
09/7013	105	FIRST NAMED APPLICANT		ATTY. DOCKET NO.
33.7.070		CUNNINGHAM	F	P108172-0002
ARENT FOX KINTH	ED DI OTK	IN G ICAL II.	INTERNATIONAL	APPLICATION NO.
1 2011 E 600		i	PCT/US	99/12121
1050 CONNECTICU	JT AVENUE	NW .		· · - · - · - · · - · · · · · · · ·
WASHINGTON, DC	20036 5339	,	I.A. FILING DATE	PRIORITY DATE
		5.0111	02 JUN 99	02 JUN 98
		19 (H 11.2) i		11 JUL 2001
NOTIFICATIO	N TO CO	MPI V WITTH PRO	DATE MAILED:	
CONTAINI	NG NUCL	MPLY WITH REQUIREMENTS I EOTIDE SEQUENCE AND/OR A DISCLOSURES	FOR PATENT AI LMINO ACID SE	PPLICATIONS QUENCE
Applicant has subm	itted none	and of the c		ė.
merica. The item	med papers S indicated	s under 35 U.S.C. 371 to enter the n	ational stage in the	United States of
enciency noted bel	ow and avo	oid abandonment is set forth in the ac	companying Noti	th to correct the
he nucleotide and/	or amino ac	sid comerce 1' t	• •	
ith the requirement	s for such	a disclosure as set forth in 27 CEP	this application do	es not comply
ason(s):		a disclosure as set forth in 37 CFR 1	1.821-1.825 for the	following
			·	
x The appli	cation fails	to comply with the requirements of	37 CED 1 021 1 6	225
	TOTAL GOOD	s not contain. A "Semience I ictina"		
		The Lighting III COMPINIER readable 6	7 37 CFR 1.821(c)	١.
required b	y 37 CFR	1.821(e).	ormat has not beer	1 submitted as
A copy of	the "Seque	ence Listing" in computer rendable 6	ama has to	
content of	the comput	ter readable form, however, does not 1.832, as indicated on the attached	orm nas been subn	nitted. The
37 CFR 1.8	322 and/or	1.832, as indicated on the attached r	comply with the	requirements of
Sequence L	isting."	on the attached i	narked-up copy of	the "Raw
The compu	iter readabl	le form that has been filed with this a	annlication has be-	
damaged a	nd/or unrea	adable as indicated on the attached C	DE Distant B	n found to be
substitute c	omputer re	eadable form must be submitted as re	conited by 27 CED	em Report. A
Ine paper	copy or cor	npact disc of the "Sequence Listing"	is not the same as	. 1.825(d).
computer r	eadable for	m of the "Sequence Listing" as requ	ired by 27 CED 1	o me
Other:			area by 37 CFR 1	.821(e).
	<u> </u>			
LICANT MUST P	BUAIDE:		•	
An initial or	Substitute:	COmputer readable c		
An initial or	enpesiere-	computer readable form (CRF) of th	e "Sequence Listin	ng."
	PROSTITION	Daper copy or compact dies of the ne	Sequence Listing."	'as well as an
	mar me col	of the paper or compact disc.	nd the computer re	eadable form
		e applicable, include no new matter, 1(g), 1.825(b) or 1.825(d).	as required by 37	CFR
QUESTIONS REC	SARDING	COMPLIANCE WITH THESE REG	QUIREMENTS, P	LEASE
(703) 308-4216	for Pulsa	into-	· - - - · - · - · - · - · - · - · - · - · - · - ·	
(703) 308-4212	for CRF	interpretation, submission help,	/	
(703) 287-0200	for Patent	In software help.	X	LAUL XI
		convare neip.	•	~[1(101)]
•				1-10001
	•			

Lamomt Hunter

Telephone: 703-305-3686

CPI

Commissioner for Patents, Box PCT United States Patent and Trademark Office Washington, D.C. 20231 www.uspto.gov

	U.S. APPLICATION NO.				. W.	ashington, D.C. 20231 www.uspto.gov
	09/701395	L	FIRST NAMED APPLICANT		ATTY. DOCK	
	03/101383	CUNN	NINGHAM	F .	£108172	-0002
	ADENT FOX :		_	INTERNATIO	NAL APPLICATION	
	ARENT FOX KINTNER PLOTK SUITE 600		/1.	PCT/	US99/12121	
	1050 CONNECTICUT AVENUE WASHINGTON, DC 20036 533	: NW	· ////	I.A. FILING DATE	PRIO	RITY DATE
1	Inches terms	"	1 250\$	99 NUL 20		
(1081 12 00000	- 24	72920	101	•	JUN 98
	NOTHEIGATION OF MIS	INCADE OLITI	Electronic	DATE MAILED	2 5 JU	L 2001
	NOTHE CATION OF MIS	DESIGNATED	ELECTED OFFI	R 35 U.S.C. 371	NATIONAL TO	NITED
	T. THE TOHOWHIS HEITHS HAVE DEED 21	iomitted by the anni	icant or the IR to the II-	Sand Co	ł. 	
			an Elected Office	(37 CFR 1 495)	Trademark	
	A G.O. DEDIC MANUAL FEE		Indication of Small Ent	ity Status.		.
	Copy of the international Cath or Declaration of ir	application.	Translation of the intern	national application is	nto English.	Received
	Copy of Article 19 amen	dments	ranslation of Article 1	9 amendments into E	inglish.	
	Priority Document.	michia.	Other:		Į.	JUL 13 0 2001
	The International Prelimi	nary Examination R	eport in English and its	Anneyes if any		- 1. 4345.
	Translation of Annexes to	the International P	reliminary Examination	Report into English	A	rent Fox
	 Applicant has requested early properties indicated items in paragraph 3 below prior to 20 or 30 months from the prior 	W. The Racic Nation	J.S.C. 371(f) but has no	t filed the following	indicated items	s and/or
	prior to 20 or 30 months from the prior	rity date to avoid al	onal ree and the copy of andonment	the international app	lication must	be filed
	U.S. Basic National Fee.	. 🖂	Copy of the international	l application.	•	
	3. The following items MUST be furn					
	 The following items MUST be furr acceptance under 35 U.S.C. 371: 	isiled width the per	nod set forth below in or	rder to complete the i	equirements f	or
•	a. Translation of the appli	cation into English.	A processing fee will b	e required if submitte	ed	
	aim: dic appion	UALE ZU UF 311 MONT	16 from the priority, days			•
			te reasons indicated on the			
	b. Processing fee for provi	ding the translation	of the application and/or	r the Annexes later th	on the	
	e or and a decistration of fi	ie niventors, in com	Diance with 37 CFD 1 A	107/a) and (b)	rly identifying	
	surcharge will be requ	tired if submitted la	tional application number ter than the appropriate	r and international fil	ing date). A	
	date.	-1	appropriate /	20 of 30 months from	i the priority	
			comply with 37 CFR 1.4			
	a. Surcharge for providing	the oath or declarati	ion later than the approp	riate 20 or 30 months	· from sh.	
	priority date (37 CFR	1.492(e)).		. ide 20 of 50 months	itom me	
	4. Additional claim fees of \$\frac{1}{2}\] claim fee, are required. Applicant must due (37 CFR 1.492(g)). See attached P	submit the addition	ntity small entity, inc al claim fees or cancel th	cluding any required in the additional claims for	nultiple depen	ndent are
						410
	5. Applicant has not submitted the re PCT/DO/EO/920.	quired sequence list	ing pursuant to 37 CFR	1.821-1.825. See at	tached	
	ALL OF THE FIRMS SET FORTH D	701 202 1 1	_			
	ALL OF THE ITEMS SET FORTH IT MONTHS FROM THE DATE OF TH THE PRIORITY DATE FOR THE AP	13(8)-3(d), 4 AND IS NOTICE OR BY	5 ABOVE MUST BE 9	SUBMITTED WITH	IIN TWO (2)	
	THE PRIORITY DATE FOR THE AP RESPOND WILL RESULT IN ABANG	PLICATION, WH	ICHEVER IS LATER.	(Where 37 CFR 1.49 FAILURE TO PR	5 applies) FR	ROM
						•
•	The time period set above may be extended 1.136(a).	d by filing a petitio	n and fee for extension	of time under the		
				•		
(If box 3a or 3c is checked, a translation Annexes will be cancelled. A processing 	n of the Annexes M	UST be submitted no la	ton than the sime of		•
	Annexes will be cancelled. A processing 7. The Article 19 amendments are can	fee will be required	if submitted later than 2	0 or 30 months from	the priority d	r the
	7. The Article 19 amendments are can or 30 (37 CFR 1.495(d)) months from the		ation was not provided b	y the appropriate 20	(37 CFR 1.49	4(d))
	tota dic	priority date.	•			
a	Applicant is reminded that any communical ddress given in the heading and include the	ition to the United S ne U.S. application	tates Patent and Tradem. no. shown above, (37 Cl	ark Office must be m	ailed to the	
E	A copy of this and an inclosed: PCT/DO/EO/917	nonce MUST	be returned with	this response.		
_	PTO-875	Notice of Defe	ective Translation		/	
_		A CINDO/EO/S	Lamor	nt Hunte/	4	
F	ORM PCT/DO/EO/905 (March 2001)		Telephone: 703	305-3646/H	/	
			DOCKETED	BATA SCH	•	
			77	7/17		

	· -		Commissioner for Patents, United States Patent and Tradema Washington, D.
U.S. APPLICATION NO.	FIRST NAMED APPLICANT		
09/701395	CUNNINGHAM ·	F	ATTY. DOCKET NO.
LADENT FOR WALL			P108172-0002 .
ARENT FOX KINTNER PLOTKIN SUITE 600	I & KAHN	PCT/US99/12121	
1050 CONNECTICUT AVENUE N	iw .		
WASHINGTON, DC 20036 5339		I.A. FILING D.	ATE PRIORITY DATE
.		02 JUN 9	9 02 JUN 98
,	PLY WITH REQUIREMENTS OTIDE SEQUENCE AND/OR DISCLOSURES	AMINO ACII	T APPLICATIONS D SEQUENCE
Applicant has submitted papers to America. The items indicated be deficiency noted below and avoid the nucleotide and/or amino acid with the requirements for such a reason(s):	1 aa au	accompanying	Which to correct the Notification.
disclosure on paper co A copy of the "Sequen required by 37 CFR 1.3 A copy of the "Sequenc content of the computer 37 CFR 1.822 and/or 1. Sequence Listing." The computer readable damaged and/or unreads substitute computer read The paper copy or comp	comply with the requirements of not contain, a "Sequence Listing" ppy or compact disc, as required to ce Listing" in computer readable 821(e). The Listing in computer readable readable form, however, does not as a submitted as indicated on the attached form that has been filed with this able as indicated on the attached to the attached of the submitted as indicated of the "Sequence Listing" as required to the sequence Listing to the "Sequence Listing" as required to the sequence Listing to the sequ	as a separate poy 37 CFR 1.82 format has not form has been of comply with marked-up copapplication has CRF Diskette I required by 37	part of the 21(c). been submitted as submitted. The the requirements of py of the "Raw s been found to be Problem Report. A CFR 1.825(d). ne as the FR 1.821(e).
amendment directing its e A statement that the conte are the same and, where a 1.821(e), 1.821(f), 1.821(f) OR QUESTIONS REGARDING CO ALL:	OMPLIANCE WITH THESE RE	Sequence Listi and the compu- , as required b	ing," as well as an ter readable form y 37 CFR
(703) 308-4216, for Rules in (703) 308-4212, for CRF sul (703) 287-0200, for Patentin	mission help		· ·,